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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/664,840      | 09/19/2000  | Edgar B. Cahoon      | BB1117 US NA        | 4919             |

23906 7590 06/18/2002

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BARLEY MILL PLAZA 25/1128  
4417 LANCASTER PIKE  
WILMINGTON, DE 19805

[REDACTED] EXAMINER

MCELWAIN, ELIZABETH F

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

1638

DATE MAILED: 06/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                    |               |
|------------------------------|--------------------|---------------|
| <b>Office Action Summary</b> | Application No.    | Applicant(s)  |
|                              | 09/664,840         | CAHOON ET AL. |
|                              | Examiner           | Art Unit      |
|                              | Elizabeth McElwain | 1638          |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 19 September 2000.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-34 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, 11, 12 and 17-19, drawn to a delta-5 acyl CoA coding sequence and transformed cells and seeds and a method of altering the expression of said enzyme in a host cell, classified in class 536, subclass 23.6, for example.
- 5 II. Claim 5 drawn to a delta-5 acyl CoA polypeptide, classified in class 530, subclass 370, for example.
- III. Claims 6-9, 11, 21-24 and 26-27, drawn to a DNA encoding a fatty acyl-CoA elongase coding sequence, and methods of producing seed oil using said coding sequence, classified in class 800, subclass 281, for example.
- 10 IV. Claim 10, drawn to a fatty acyl CoA elongase polypeptide, classified in class 530, subclass 370, for example.
- V. Claims 13 and 14 drawn to a seed comprising fatty acids with a double bond in the delta-5 position, classified in class 800, subclass 298, for example.
- 15 VI. Claims 15, 16 and 20, drawn to oil obtained from a seed comprising fatty acids with a double bond in the delta-5 position, classified in class 554, subclass 8, for example.
- VII. Claim 25, drawn to oil with reduced levels of 16 carbon fatty acids, classified in class 562, subclass 598, for example.
- 20 VIII. Claim 30, drawn to oil with increased levels of 20 carbon fatty acids, classified in class 426, subclass 603, for example.

- IX. Claim 31, drawn to a method of obtaining a nucleic acid using SEQ ID NO: 2, 5 or 7, classified in class 800, subclass 264, for example.
- X. Claim 24, drawn to a method of obtaining a nucleic acid by hybridizing with SEQ ID NO: 1, 4 or 6, classified in class 800, subclass 312, for example.

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The inventions are distinct, each from the other because:

The inventions of Groups I-X are distinct methods and products given that each method requires different method steps and different components, and each results in the production and isolation of chemically and structurally distinct products. The DNA of Groups I and III encode structurally and functionally different proteins and the proteins of Groups II and IV can be made by a different method than by using the isolated DNA of Groups I and III, such as by extraction from tissue or by chemical synthesis. In addition, oil of each of Groups VI-VIII differs in composition one from each of the others and one does not require any of the others. Furthermore, the seed of Group V can be made by a different method than by use of any of the DNA or proteins of Groups I-IV, such as by breeding. Therefore, each of the products of Groups I-VIII are structurally and functionally distinct. Furthermore, the methods of Groups III-IX and XIV each differ one from the other in that they use different starting materials require different method steps and result in different products. In addition, the methods of Groups IX and X are not required by each other, nor are they required for the production of the claimed products, as each product can be made by an alternative method using different starting materials and different method steps, and one is not required by the other. Thus the

inventions of Groups I-X are each capable of being separately made, independently used and the patentability of one would not render the other obvious or unpatentable.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent 5 subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 10 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 15 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (703) 308-1794. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

20 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone number for this Group is (703) 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

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Any inquiry of a general nature or relating to the status of this application should be directed to the legal analyst, Gwendolyn Payne, whose telephone number is (703) 305-2475, or to the Group receptionist whose telephone number is (703) 308-0196.

5      Elizabeth F. McElwain, Ph.D.  
June 13, 2002

ELIZABETH F. McELWAIN  
PRIMARY EXAMINER  
GROUP 1600

